

REMARKS

This Response, filed in reply to the Office Action dated December 1, 2006, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Claims 1-16 remain pending in the Office Action. Claims 1-3, 5 and 12 have been rejected under 35 U.S.C. § 103 as being unpatentable over Faupel in view of Walker (U.S.P. 6,690,958). Claims 4, 6-11 and 13-14 have been rejected under 35 U.S.C. § 103 as being unpatentable over Faupel in view of Cline. Applicant respectfully submits the following arguments in traversal of the prior art rejections.

As an initial matter, Applicant submits that the finality of the Office Action should be withdrawn. The Examiner has applied a new reference Walker against the pending claims 1-3, 5 and 12. However, none of these claims were amended. Therefore, the subject matter recited in these claims were previously before the Examiner. The Examiner had full and fair opportunity to apply Walker against these claims in the previous Office Action but failed to do so. It is improper and highly prejudicial to the Applicant for the Examiner to apply a new reference against these claims on a final basis. Therefore, the finality of the rejection should be withdrawn.

The rejection is also improper as a substantive matter. The Examiner concedes that Faupel does not teach a contact detecting means for detecting that a distal end of excitation light has come into contact with the target tissue. The Examiner cites Walker to make up for this deficiency. However, Walker does not qualify as prior art under any provision of 35 U.S.C. § 102. In particular, Walker was filed on May 7, 2002. By contrast, Applicant's invention has an

effective constructive reduction to practice date (i.e. invention date) of at least June 26, 2001.¹

Therefore, Applicant invented the present invention before Walker, and the reference does not qualify as prior art under 35 U.S.C. § 102(a). Similarly, Walker was published after the filing date of the present application and was filed after the application filing date for the present invention and thus cannot qualify as prior art under 35 U.S.C. § 102(b) or 102(e). Therefore, the rejection over Faupel and Walker does not support the rejection of claims 1-3, 5 and 12.

With further regard to claims 4, 6-11 and 13-14, the Examiner rejects these claims over Faupel and Cline. However, claim 4 is depends on claim 1. The Examiner concedes that Faupel alone does not teach the contact detecting means for detecting that a distal end of excitation light has come into contact with the target tissue of the base independent claim 1. Therefore, the rejection over claim 4 is improper. Independent claim 5 includes a similar recitation regarding a means for detecting correlating the distance between a distal end of the excitation light and the target tissue. The conceded deficiency of this means of claim 5 is conceded to be missing from Faupel. Cline does not make up for this deficiency. Therefore, claims 6-1 and 13-14 are patentable.

The Examiner has failed to provide any basis of rejection for new claims 15-16. Therefore, these claims are patentable.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

¹ Perfection of the foreign priority date would set an even earlier effective filing date or construction reduction to practice date.

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 09/888,444

Attorney Docket No. Q65160

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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